

## REMARKS

In the outstanding Office Action dated January 28, 2003, the Examiner rejected claims 5-13 under 35 U.S.C. § 102(e) as being anticipated by Pham et al., U.S. Patent No. 6,171,780.

Applicant proposes to amend claim 5 to correct a minor typographical error. No new issues are raised by the amendment.

Claim 5 recites a combination including a plastic body, a glass base, the base of the microtiter plate having a thickness ranging from 0.07 to 0.2 mm, a number of vessels for containing samples, wherein the number of vessels ranges from 1000 to 4000 vessels, the diameter of the vessels ranges from 1.0 to 1.8 mm, and the distance between the center of the outer vessels and an edge of the glass base ranges from 4 to 11 mm, and a lid to prevent evaporation.

The Examiner asserted that Pham et al. discloses a low fluorescence platform that contains a large number of wells for assaying compounds. The Examiner stated that the platform may contain between 50 and 10,000 wells, that the frame may be made of "any material, such as polymers, such as polystyrene or cycloolefins, or other materials such as glass or quartz." The Examiner further stated that the base may be made of glass, and that the frame and base may be made of the same or different materials.

With regard to the wells, the Examiner stated that the wells may have a diameter of between 0.2 and 50 mm, and a thickness of between 10-1000 micrometers. Finally, the Examiner states that providing a distance between the center of the outer vessels

and an edge of the glass base of between 4 and 11 mm as claimed by Applicant is inherent to Pham.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(emphasis added). See also M.P.E.P. §2112.

In the present case, the Examiner has not established that Pham’s disclosure of a microtiter plate comprised of various elements, each element having an extremely broad range of a characteristic of interest, such as for example, thickness of the base and diameter of the well, is necessarily a teaching that the distance between the center of the outer vessels and an edge of the glass base is between 4 and 11 mm, as recited in claim 5. Indeed, Applicant submits there are thousands of permutations of a microtiter plate that one of ordinary skill might create from the broad teachings of Pham. Some permutations may include a distance between the center of the outer vessels and an edge of the glass base of between 4 and 11 mm, while others would not. Therefore, a distance between the center of the outer vessels and an edge of the glass base of between 4 and 11 mm does not necessarily flow from the teachings Pham. Therefore, Pham does not inherently disclose Applicant’s claim 5. Reconsideration is requested.

“In order to anticipate the claims, the claimed subjected matter must be disclosed in the reference with ‘sufficient specificity to constitute anticipation under the

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statute.” See MPEP § 2131.03 In the instant case, the claims of the present application include elements defined by specific ranges, while Pham teaches broad ranges, often without specific examples falling within the claimed range. Applicant therefore asserts that the specific ranges claimed in this application are not disclosed with “sufficient specificity” in Pham to constitute an anticipation of claims 5-13. See MPEP § 2131.03

Claim 5 recites that the base of the microtiter plate has a thickness ranging from 0.07 to 0.2 mm. Pham teaches a base thickness of 10-1000 micrometers (.010-1.0 mm) in column 13, lines 60-68, with a most preferred range being between 20 and 100 micrometers (.020 and 0.1 mm).

Claim 5 recites that the diameter of the vessels ranges from 1.0 to 1.8 mm. Pham teaches a vessel diameter of between 0.2 and 100 mm, with a most preferred range being between 2 and 20 mm. See column 13, lines 3-10.

Claim 5 recites that the distance between the center of the outer vessels and an edge of the glass base ranges from 4 to 11 mm. Pham is completely silent with regard to this measurement. The Examiner acknowledged that Pham does not disclose this element, but argued that it is inherent.

With regard to the distance between the center of the outer vessels and an edge of the glass base being between 4 and 11 mm, the Examiner sets forth calculations based on dimensions found in Table I of Pham and in columns 11 and 12 of Pham. Specifically, the Examiner assumed that a multiwell platform has an 85.5 mm by 127.75 mm base, and asserted that these base dimensions were taken from Table I of Pham. However, Pham and Table I do not disclose such base dimensions, but rather disclose a frame or footprint dimension (see column 10, lines 15-16 and lines 34-36). Claim 5

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recites in relevant part, "distance between the center of the outer vessels and an edge of the glass base," emphasis added.

Further, as shown in Figs. 2 and 3 of the present application, the glass base 2 does not extend to the outer edge of the frame 1, which defines the footprint of the plate. It is unclear whether the base of Pham extends to the edge of the frame or not because Pham does not discuss or show the construction of the entire device. Pham does state that the base and frame may or may not be integrally formed (col. 15, lines 44-50), however Pham gives no guidance as to where the base ends and the frame begins. Without any specific measurements provided for the base, one determine the distance between the center of the outer vessels and an edge of the glass base in Pham. Thus, Pham does not disclose or inherently suggest a distance between the center of the outer vessels and an edge of the glass base being between 4 and 11 mm.

Finally, the Examiner chose a number of wells on which to base his calculations. In column 11, lines 44-59, Pham teaches that between 50 and 10,000 vessels may be used. The Examiner choose the number 1536 wells. While this specific number is supported by Pham, it is not supported in conjunction with the base dimensions chosen by the Examiner. That is, Table I of Pham, from which the Examiner took the dimensions, lists the number of wells contained in each plate. None of the devices listed in that table has a number of wells approaching that claimed by applicant. Claim 5 requires that the number of vessels be between 1000 and 4000 vessels. The highest number of vessels set forth in Pham's Table I is 384 vessels. Applicant asserts that the density of the vessels may affect the footprint dimensions. In addition, the Examiner also chose a well center to well center spacing. Pham teaches that this spacing may be

0.5 to 100 mm. The Examiner arbitrarily selected the spacing of 0.5 mm, again without any specific teaching or reason to do so. For these reasons, Applicant submits that the Examiner cannot rely on the dimensions set forth in Table I for his calculation.

For Pham to anticipate the claimed invention, Pham must clearly and unequivocally disclose the claimed combination of elements within their specific claimed ranges or direct those skilled in the art to the specific claimed ranges "without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." See In re Arkley, 455 F.2d 586, 587 (C.C.P.A. 1972). "Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a single prior art reference, there is no anticipation." General Battery Corp. v. Gould, 545 F. Supp. 731, 744 (D. Del. 1982). In Pham, the references which in combination allegedly anticipate the present invention as claimed are scattered throughout the patent, and one would have to pick and choose among the elements and ranges taught to piece together a microtiter plate as presently claimed. Id. Reconsideration is requested.

The specific combination of elements within the claimed ranges results in a microtitration plate that provides unexpected results and several advantages over the prior art references, including Pham. As set forth on pages 2 and 3 of the specification, the specific combination of elements within the claimed ranges permits the resulting microtiter plate to be used with confocal optics, a very sensitive method of detection for which Pham's teaching is silent and Pham's device as disclosed is unsuitable. The microtiter plate as recited in claim 13 is especially configured to be used with confocal optics to allow single molecule detection. The configuration of the plate to be used with

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confocal optics provides several other benefits as well, as discussed on page 3 of the specification.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 5-13 in condition for allowance. Applicant submits that the proposed amendments of claim 5 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

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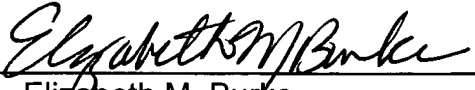
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Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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